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WASHINGTON DC 20005

**MAILED**

**JAN 31 2011**

**OFFICE OF PETITIONS**

In re Application of :  
Paul GERMERAAD et al. :  
Application No. 09/545,564 : DECISION ON PETITION  
Filed: April 7, 2000 :  
Attorney Docket No. 2222.0390001 :  
(1531.0310001) :

This is a decision on the petition under the unavoidable provisions of 37 CFR 1.137(a), filed March 8, 2004, to revive the above-identified application. The delay in responding to the petition is regretted. The decision includes a response to the Request for refund of petition fee filed concurrently with the petition noted above.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The Request for a Refund of the petition fee is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, May 21, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 22, 2002.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks items (1) and (3).

Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

Specifically, the application is “unavoidably” abandoned where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.

35 U.S.C. 133 and 151 each require a showing that the “delay” was “unavoidable,” which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See In re Application of Takao, 17 USPQ2d 1155 (Comm’r Pat. 1990). The burden of continuing the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. Id. at 1158. Thus, an applicant seeking to revive an “unavoidably” abandoned application must cause a petition under 37 CFR 1.137(a) to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

Therefore, there are three periods to be considered during the evaluation of a petition under 37 CFR 1.137:

- (1) the delay in reply that originally resulted in the abandonment;
- (2) the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and
- (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137 to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unavoidable for periods (1) and (2).

Petitioner asserts that the delay in filing a proper reply was unavoidable as the applicant did not receive a copy of the final Office action. Petitioner further says that "Applicants' files indicate that a Decision on Request for Withdrawal as Attorney in the above identified application was granted on May 15, 2002, relieving former counsel, Sterne, Kessler, Goldstein & Fox PLLC of responsibility in this action, and indicating that further correspondence would be sent to Aurigin Systems, Inc., the assignee at that time. Applicants' files also indicate that no correspondence was, in fact, received from the U.S. Patent and Trademark Office between the Decision on Request for Withdrawal as Attorney and the Notice of Abandonment. Applicants' undersigned attorney assumed responsibility from MicroPatent L.L.C., purchaser of the assets of Aurigin Systems, Inc. around May 15, 2002, and submitted a Power of Attorney, among other papers, on August 7, 2002, after a review of the files was complete. Applicants' undersigned attorney's attempts to obtain a copy of the May 21, 2002 Office Action have not been successful, to date, and therefore it remains unclear to which address the Office Action was mailed. Therefore, analyzing the potential alternatives, the Office Action was either directed to former counsel, or to the prior Assignee, which had effectively ceased operations. Had the Office Action been directed to and received by either party, it should have been forwarded to our offices, however, there is no evidence of any such receipt. It is therefore respectfully submitted that the application was unavoidably abandoned, and that it should be restored to the active docket. It is further respectfully submitted that, since the outstanding Office Action has not yet been made available to applicants, that the failure to respond to any requirements or rejections made therein should be excused until a reasonable time after receipt thereof."

The records indicate that there was no irregularity in the mailing of the Office action as it was mailed to the correspondence address of record. The assignee of record at that time - Aurigin Systems, Inc., was notified via the decision on the request to withdraw as attorney, that all future correspondence would be mailed to the assignee. Petitioner states that he "assumed responsibility from MicroPatent L.L.C., purchaser of the assets of Aurigin Systems, Inc. around May 15, 2002, and submitted a Power of Attorney, among other papers, on August 7, 2002, after a review of the files was complete." The Power of attorney along with a request for change in Correspondence

address was filed by the petitioner herein on August 12, 2002, with a certificate of mailing dated August 7, 2002. However, petitioner has not included any evidence with the instant petition to show that the assignee Aurigin Systems, Inc did not receive the final Office action of May 21, 2002. Petitioner's states in the petition: "[a]pplicants' files also indicate that no correspondence was, in fact, received from the U.S. Patent and Trademark Office between the Decision on Request for Withdrawal as Attorney and the Notice of Abandonment." It is unclear from the petition as to any evidence gathered from the "review of the files" in regard to the correspondence received from the Office pertaining to matters associated with the instant application.

Under the circumstances, petitioner has not carried his burden of proof to show that the delay was unavoidable as required by statute and by regulations of the Office. Petitioner is reminded that a petition to revive an application under 37 CFR 1.137(a) cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Haines v. Quigg, *supra*.

If petitioner cannot provide the evidence necessary to establish unavoidable delay, or simply does not wish to, petitioner may wish to consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$1,620 petition fee or the \$ 810 petition fee if the applicant qualifies as a small entity.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

In regard to the Request for refund of the petition fee, petitioner should note that 35 U.S.C. 41(a) (7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by the petition fee set forth in 37 CFR 1.17(m), unless the petition is filed under 35 U.S.C. 133 or 151 (on the basis of unavoidable delay), in which case the fee is set forth in 37 CFR 1.17(l). Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived. In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7)

means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 (“[t]he fees set forth in this section are due on filing the petition”). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee. Accordingly, the Request for Refund of the petition fee associated with the instant petition under 37 CFR 1.137(a) is DISMISSED.

The address listed on the petition differs from the Correspondence Address of record. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

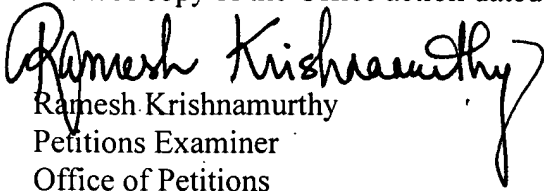
Further correspondence with respect to this matter should be addressed as follows:

By Mail:                   Mail Stop PETITION  
                              Commissioner for Patents  
                              P. O. Box 1450  
                              Alexandria, VA 22313-1450

By hand:                 U. S. Patent and Trademark Office  
                              Customer Service Window, Mail Stop Petitions  
                              Randolph Building  
                              401 Dulany Street  
                              Alexandria, VA 22314

By facsimile:           (571) 273-8300  
                              Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4914. A copy of the Office action dated May 21, 2002, is included herewith.

  
Ramesh Krishnamurthy  
Petitions Examiner  
Office of Petitions

CC:   MILDE & HOFFBERG LLP  
      10 Bank Street - Suite 460  
      White Plains, NY 10606

Enclosure: Copy of the Office action of May 21, 2002.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,564	04/07/2000	Paul Gemeraad	1531.0310001	1827

7590

05/21/2002

Aurigin Systems, Inc.  
10710 North Tantau Avenue  
Cupertino, CA 95014-0717

EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 05/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

PA

# Office Action Summary

Application No.

09/545,564

Applicant(s)

GERMERAAD ET AL.

Examiner

Jean M Corrielus

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply .

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 27 February 2002 .
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_ .  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9 . 6) ☐ Other:

Art Unit: 2172:

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on 02/27/02 (paper no.7) in which claims 2, 3, 10, 18, 19, 20 and 27 are amended.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 2-34 have been considered but are moot in view of the new ground(s) of rejection necessitated by amendment.

#### ***Information Disclosure Statement***

3. The information disclosure statement filed on 03/14/02 (paper no.9) complies with the provisions of M.E.P.. § 609. It has been placed in the application file. The information referred to therein has been considered as to the merits

#### ***Terminal Disclaimer***

4. The terminal disclaimer filed on 02/27/02 (paper no.8) disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the full statutory term of any patent granted on pending second application has been reviewed and is accepted. The terminal disclaimer has been recorded.



Art Unit: 2172:

***Claim Rejections - 35 U.S.C. § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 2-3 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art (specification pages 3-6) in view of Robert Mylls "Information Engineering CASE practices and techniques".

As to claim 2, Applicants' admitted prior art (specification pages 3-6) discloses a research and development projects typically go through a variety of stages before an idea can be commercialized or launched as a final product and facilitates sequential stages of a research and development project. However, Applicants' admitted prior art does not explicitly disclose the use of accessing a tool box and associating said tool with one or more tasks of the sequential stages.

Art Unit: 2172:

On the other hand, Robert (pages 181-201) discloses the recited limitations “accessing a tool box comprising a plurality of tool wherein each of said tools is associated with one or more tasks of the sequential stages” (pages 181-201); “selecting a task associated with one of the sequential stages of the research” (pages 181-201); invoking a tool from said tool box applicable to said selected task (pages 181-201) and performing said selected task using said invoked tool” (pages 181-201).

It would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to modify Applicants' admitted prior art, wherein the sequential stages of a research and development project, provided thereof (see applicants' admitted prior art pages 3-6) would associate a tool with one or more task of the sequential stage of the research and development project, in the same conventional manner as suggested by Robert (pages 181-201). The motivation being to allow analysts and designers to select the target environment, thereby automatically tailoring the deliverables and generating code and output display to prevent inadvertent changes rippling across production system .

As to claims 3, Robert discloses the claimed “invoking a tool for generating a feature grouping chart” (pages 181-201).

The limitations of claims 18-20 have been noted in the rejection of claimed 2-3 above. They are, therefore, rejected under the same rationale.

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7. Claims 4-17 and 21-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted prior art (specification pages 3-6) in view of Robert Mylls "Information Engineering CASE practices and techniques" as applied to claims 2-3 and 18-20 above and further in view Narin et al (article entitled "Technological performance assessments based on patent and patent citations").

As to claims 4-10, Applicants' admitted prior art and Robert Mylls disclose substantially the invention as claimed. However, Applicants' admitted prior art and Robert do not explicitly disclose wherein the stages is an idea stage of selecting a group of patent, inventorship.

Narin, on the other hand, discloses the use an inventorship (page 176), wherein the inventors is identified those who have worked in an area pertaining to an idea of a user company (pages 176, 178) and the use of technology classification (pages 176-177). It would have been obvious to one of ordinary skill in the art of data processing, at the time the present invention was made to modify Applicants' admitted prior art, wherein the sequential stages of a research and development project, provided thereof (see applicants' admitted prior art pages 3-6) would incorporate the use wherein the stages is an idea stage of selecting a group of patent, inventorship. One having ordinary skill in the art would have found it motivated to utilize such a modification so that one could develop a relatively objective measure of the degree of technology interaction, in advance of any detailed analysis.

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As to claims 11-17, Applicants' admitted prior art, Robert Mylls and Narin disclose substantially the invention as claimed. In addition, Narin discloses the use of generating a patent count per year (page 178), assignee (page 175), patent citation (page 173) and generating a patent/ month to issue (page 178).

As to claims 21-34:

The limitations of claims 21-34 have been noted in the rejection of claimed 4-17 above. They are, therefore, rejected under the same rationale.

#### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MEP. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

a shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Serial Number: 09/545,564:

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Art Unit: 2172:

Any inquiry concerning this communication or early communication from the Examiner should be directed to Jean Corrielus whose telephone number is (703) 306-3035. The Examiner can normally be reached on the weekdays from 7:00am to 5:30pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, *Kim Vu*, can be reached on (703)305-9343.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington, D.C. 20231 or faxed to:

(703) 746-7239, (for formal communications intended for entry) Or: (703)746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT") Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).



Jean M. Corrielus

Patent Examiner

May 16, 2002